

**REMARKS**

The Office Action of March 17, 2004, has been received and reviewed.

Claims 1-24 are currently pending and under consideration in the above-referenced application. Each of claims 1-24 stands rejected.

Reconsideration of the above-referenced application is respectfully requested.

**Rejections Under 35 U.S.C. § 112, Second Paragraph**

Claims 1-14 stand rejected under 35 U.S.C. § 112, second paragraph, for reciting subject matter which is allegedly indefinite. Specifically, it has been asserted that “[i]t is unclear whether the mouthpiece and the breathing apparatus in claim 1 are the same or if they constitute separate elements.” Office Action of March 17, 2004, page 2.

Independent claim 1 has been amended to recite that the breathing apparatus comprises “at least one of a mouthpiece and a mask” and a conduit with a first end that is “coupled to the breathing apparatus . . .”

It is respectfully submitted that this amendment to independent claim 1 resolves any confusion and that independent claim 1 is, therefore, in condition for allowance under 35 U.S.C. § 112, second paragraph.

It appears that claims 2-14 were merely rejected for depending from claim 1.

For these reasons, withdrawal of the 35 U.S.C. § 112, second paragraph, rejections of claims 1-14 is respectfully requested.

It is further submitted that this amendment to independent claim 1 actually broadens the scope of independent claim 1 and, thus, should not be deemed to limit the scope of independent claim 1.

**35 U.S.C. § 102(b) Anticipation Rejections**

Claims 15-17 stand rejected under 35 U.S.C. § 102(b) for being drawn to subject matter which is purportedly anticipated by the disclosure of U.S. Patent 5,823,184 to Gross (hereinafter “Gross”).

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single reference which qualifies as prior art under 35 U.S.C. § 102. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Independent claim 15 recites a breathing conduit that includes a first end, a second end, and at least a section located between the first and second ends and that is configured to be formed to a desired shape. The first end of the conduit is configured to be coupled to a breathing apparatus that is configured to communicate with an airway of an individual. The second end of the conduit is configured to be coupled to apparatus for monitoring the individual's respiration.

It is respectfully submitted that the amendment of independent claim 15 has not been made in response to the rejection but, rather, to broaden the scope thereof. Accordingly, the amendment of independent claim 15 should not be considered to limit the scope thereof.

Gross describes a corrugated, coaxial breathing circuit that is configured to retain its shape. As illustrated and described by Gross, the corrugated, coaxial breathing circuit includes one end that is configured to be coupled to an endotracheal tube and another end that is configured to be coupled to a Y-piece (or "wye" piece).

Gross lacks any express or inherent description that either end of the corrugated, coaxial breathing circuit thereof may be coupled to a sensor for monitoring an individual's respiration. Therefore, Gross does not anticipate each and every element recited in independent claim 15, as would be required to maintain the 35 U.S.C. § 102(b) rejection of independent claim 15.

Claims 16 and 17 are both allowable, among other reasons, for respectively depending directly and indirectly from claim 15, which is allowable.

### **Rejections Under 35 U.S.C. § 103(a)**

Claims 1-24 stand rejected under 35 U.S.C. § 103(a).

The standard for establishing and maintaining a rejection under 35 U.S.C. § 103(a) is set forth in M.P.E.P. § 706.02(j), which provides:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Murdock in View of Gross

Claims 1, 2, 5, 12, 13, 15-17, 19-21, and 23 have been rejected under 35 U.S.C. § 103(a) for reciting subject matter which is purportedly unpatentable over the subject matter taught in U.S. Patent 6,581,595 to Murdock et al. (hereinafter "Murdock"), in view of teachings from Gross.

Murdock teaches a calorimetry system that includes a mouthpiece or mask, a breathing circuit, and a calorimetry device. One end of the breathing circuit is coupled to the mouthpiece or mask, while the other end of the breathing circuit is coupled to the calorimetry device.

The teachings of Gross have been summarized above.

It is respectfully submitted that the asserted combination of references does not support a *prima facie* case of obviousness against any of claims 1, 2, 5, 12, 13, 15-17, 19-21, or 23.

In particular, it is respectfully submitted that one of ordinary skill in the art would not expect the corrugated, coaxial breathing circuit of Gross to work in the calorimetry system of Murdock. Specifically, the teachings of Murdock are limited to a calorimetry system that includes a single lumen breathing circuit and a calorimetry system that is coupled to an end of the single lumen breathing circuit. One of ordinary skill in the art would have no reason to expect that the coaxial breathing circuit of Gross could not be coupled to the single lumen-receiving calorimetry device of Murdock.

Moreover, it is respectfully submitted that one of ordinary skill in the art would not have been motivated to combine the teachings of Murdock and Gross in the manner that has been asserted. This is because neither Murdock nor Gross includes any teachings or suggestions that

would have provided one of ordinary skill in the art with any motivation to use a coaxial breathing circuit, such as that taught in Gross, in the calorimetry system of Murdock. More specifically, neither Murdock nor Gross provides any teaching or suggestion that an end of a coaxial breathing circuit may be coupled to a calorimetry device or any other type of respiratory monitor. Based on the foregoing, it appears that any motivation to combine the teachings of Murdock and Gross in the manner that has been asserted could only have been gleaned from improper hindsight reliance upon the subject matter that is taught and claimed in the above-referenced application.

As a *prima facie* case of obviousness has not been established against any of claims 1, 2, 5, 12, 13, 15-17, 19-21, or 23, it is respectfully submitted that each of these claims is allowable under 35 U.S.C. § 103(a).

Kenny in View of Gross

Claims 1-4, 6-13, 15-17, 19-21, and 23 stand rejected under 35 U.S.C. § 103(a) for being directed to subject matter which is assertedly unpatentable over teachings from U.S. Patent 5,042,501 to Kenny et al. (hereinafter “Kenny”), in view of the teachings of Gross.

Kenny teaches a system that includes a mouthpiece, a single-lumen breathing circuit, and a mixing chamber. The teachings of Kenny are limited to coupling a first end of the breathing circuit to the mouthpiece and coupling the opposite end of the breathing circuit to an inlet tube of the mixing chamber.

The teachings of Gross were summarized previously herein.

It is respectfully submitted that there are several reasons that a *prima facie* case of obviousness has not been established against any of claims 1-24.

With respect to the subject matter recited in independent claim 1, it is respectfully submitted that neither Kenny nor Gross, taken either together or separately, teaches or suggests a conduit that includes a first end that is coupled to a mouthpiece and a second end that is configured to be coupled to an apparatus for monitoring an individual’s respiration.

As for the subject matter recited in independent claim 15, as amended and presented herein, it is respectfully submitted that Kenny and Gross, taken collectively or individually, do

not teach or suggest a breathing conduit that includes an end configured to be coupled to a sensor for monitoring an individual's respiration.

Independent claim 19 is drawn to a method for obtaining a resting metabolic rate of an individual. The method of independent claim 19, as amended and presented herein, includes placing the individual in a resting position, placing a breathing apparatus flow communication with an airway of the individual, and coupling a conduit to the breathing apparatus and to an apparatus for monitoring the individual's respiration. At least a portion of the conduit is also formed to a desired shape, with the conduit being configured so as to substantially maintain the desired shape.

It is respectfully submitted that the amendment of independent claim 15 has not been made in response to the rejection but, rather, to broaden the scope thereof. Accordingly, the amendment of independent claim 15 should not be considered to limit the scope thereof.

Again, both Kenny and Gross, taken together or separately, lack any teaching or suggestion of a method that includes coupling a breathing circuit to both a breathing apparatus and a sensor for monitoring an individual's respiration.

Additionally, it is respectfully submitted that one of ordinary skill in the art would have been motivated to combine the teachings of Kenny and Gross in the manner that has been asserted. Like Murdock, the teachings of Kenny are limited to securing a single-lumen tube to another device, in this case a mixing chamber. The connection of the coaxial breathing circuit of Gross to the mixing chamber of Kenny would have no value, as inspired and expired gases would no longer be separated from one another. Thus, it appears that any motivation to combine the teachings of Kenny and Murdock could only have been based upon improper reliance upon the hindsight provided by the subject matter taught and claimed in the above-referenced application.

For the same reasons, it is respectfully submitted that one of ordinary skill in the art would have no reason to expect the asserted combination of teachings from Kenny and Gross to be successful.

It is, therefore, respectfully submitted that a *prima facie* case of obviousness has not been established against any of claims 1-3, 6-13, 15-17, 19-21, or 23.

Murdock in View of Gross and, Further, in View of Hanson

Claims 14, 18, and 22 stand rejected under 35 U.S.C. § 103(a) for being directed to subject matter which is allegedly unpatentable over the subject matter taught in Murdock, in view of teachings from Gross and, further, in view of the teachings of U.S. Patent 5,769,702 to Hanson (hereinafter “Hanson”).

The teachings of Hanson are directed to a flexible wand and a malleable positioning tube.

It is respectfully submitted that Hanson includes no teachings or suggestions that remedy the aforementioned deficiencies of Murdock and Gross with respect to providing one of ordinary skill in the art with some motivation to combine the teachings of these references in the asserted manner or some reason to expect that the asserted combination of teachings from these references would be successful. Therefore, Murdock, Gross, and Hanson cannot be relied upon to establish a *prima facie* case of obviousness against any of the claims of the above-referenced application.

Further, it is respectfully submitted that claim 14 is allowable for depending from claim 1, claim 18 is allowable for depending from claim 15, and claim 22 is allowable for depending from claim 19.

Kenny in View of Gross and, Further, in View of Mault

Claim 24 stands rejected under 35 U.S.C. § 103(a) for being drawn to subject matter which is purportedly unpatentable over teachings from Kenny, in view of teachings from Gross and, further, in view of the subject matter taught in U.S. Patent 5,038,792 to Mault (hereinafter “Mault”).

Mault describes a portable apparatus that includes a flow tube through which exhaled gases pass into a scrubber. From the scrubber, the gases pass through another tube into a flow meter.

Mault does not teach or suggest that an end of the flow tube is coupled to a breathing apparatus. Nor does Mault teach or suggest that another end of the flow tube is coupled to the flow meter. Therefore, Mault does not include any teaching or suggestion that would remedy the deficiencies of Kenny and Gross with respect to providing one of ordinary skill in the art with

some motivation to combine the teachings of these references in the manner that has been asserted or with some reason to expect that the asserted combination would be successful. Therefore, Kenny, Gross, and Mault cannot be relied upon to establish a *prima facie* case of obviousness against any of the claims of the above-referenced application.

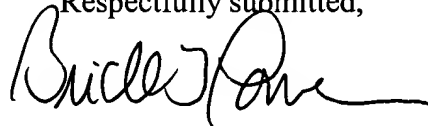
It is also respectfully submitted that claim 24 is allowable for depending from claim 19, which is allowable.

For the foregoing reasons, withdrawal of the 35 U.S.C. § 103(a) rejections of claims 1-24 is respectfully requested.

### CONCLUSION

It is respectfully submitted that each of claims 1-24 is allowable. An early notice of the allowability of each of these claims is respectfully solicited, as is an indication that the above-referenced application has been passed for issuance. If any issues preventing allowance of the above-referenced application remain which might be resolved by way of a telephone conference, the Office is kindly invited to contact the undersigned attorney.

Respectfully submitted,



Brick G. Power  
Registration No. 38,581  
Attorney for Applicants  
TRASKBRITT, PC  
P.O. Box 2550  
Salt Lake City, Utah 84110-2550  
Telephone: 801-532-1922

Date: June 17, 2004

BGP/dlm:rmh  
Document in ProLaw